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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,456	05/02/2001	Marie-Francoise Rosier-Montus	3806.0505	1457

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EXAMINER

LEFFERS JR, GERALD G

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 11/19/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/846,456		ROSIER-MONTUS, ET AL.	
	Examiner		Art Unit	
	Gerald G Leffers Jr.		1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 39-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13, 15-17 and 23-34 is/are rejected.
- 7) ☒ Claim(s) 7-12, 14, 18-22 and 35-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I (claims 1-38) in Paper No. 8, filed 9/6/02, is acknowledged. The traversal is on the ground(s) that the examiner has not met the criteria for establishing a burdensome search requirement for combinations of the different groups, particularly between Group I and the remaining groups. The response asserts that a thorough search of the nucleic acids of Group I would encompass the search required for the other groups. This is not found persuasive because of several reasons. First, the response ignores the reasons provided by the examiner as to why the different groups have achieved a separate status in the art. In addition, the showing of a different classification for two different groups is all that need be shown in order to demonstrate a burdensome search requirement in examining the two groups together in the same application. Finally, for those groups having the same classification, the non-patent literature search required for the different groups is not the same. For example, a reasonable search of the nucleic acids of Group I does not necessarily include each and every possible application to which the nucleic acids might be directed.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

Receipt is acknowledged of an IDS filed 11/01/01 as Paper No. 6. The corresponding PTO Form 1449 has been mailed with this action.

Art Unit: 1636

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is more than 150 words in length and comprises more than a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 35-38 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiply dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-17, 24-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1636

Claims 16-17, 24-26 are vague and indefinite in that there is no clear and positive prior antecedent basis for the term "said nucleic acid" in the claims upon which these claims are dependent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 13, 15-16, 23-24, 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Langmann et al (Biochemical and biophysical Research Communication, 2/9/1999, Vol. 257:29-33; see the entire document).

Langmann et al teach the purification and characterization of a full-length cDNA (~6.8 kb) for the human ABC1 transporter that was given the accession number AJ012376 (e.g. Abstract; page 30, 1st paragraph Results and Discussion). The attached NCBI readout for AJ012376 indicates that the full-length cDNA taught by Langmann et al comprises the first 120 nucleotides 5' of the coding sequence. This 5' coding sequence would necessarily "modify" the transcription of the coding sequence under its control.

Claims 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Auffray et al (C. R. Acad. Sci. III, Sci. Vie 318, No. 2, pages 263-272; see the search reports attached to the instant action).

Art Unit: 1636

As indicated by the attached search reports, Auffray et al teach the sequence the sequence of a cDNA clone obtained from the infant brain. The sequence taught by Auffray et al comprises greater than 20 contiguous nucleotides of SEQ ID NOS: 2, 4 and 5.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Feder et al (U.S. Patent No. 5,872,237; see the search report attached to the first page of the issued patent).

According to the search report attached to the first page of the '237 patent, the sequence described by SEQ ID NO: 20 of the patent comprises several sequences having greater than 20 contiguous nucleotides of SEQ ID NO: 1 of the instant application. It is noted the issued patent is an ~700 page document. If applicants request, the entire patent will be supplied to applicants.

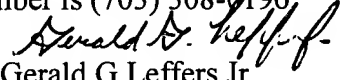
Conclusion

No claims are allowed. Claims 7-12, 14, 18-22 are objected to as being dependent upon a rejected claim. Claims 35-38 are objected to as being improperly multiply dependent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr. whose telephone number is (703) 308-6232. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7939 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Gerald G Leffers Jr.
Examiner
Art Unit 1636

Ggl
November 18, 2002